**UNITED STATES DEPARTMENT OF COMMERCE**
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/003,428 | 01/05/98 | KNOWLTON | 16904725 |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 3739 | 6 |

**DATE MAILED:** 01/14/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

| Application No. | Applicant(s) | |
|---|---|---|
| Examiner | Group Art Unit | |

***—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—***

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

☑ Responsive to communication(s) filed on April 27, 1998.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

☑ Claim(s) 1-60 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☑ Claim(s) 1-60 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

**Attachment(s)**

☑ Information Disclosure Statement(s), PTO-1449, Paper No(s)._____

☐ Interview Summary, PTO-413

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☑ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other_____

**Office Action Summary**

Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the meaning of the term "surface n contact" is unclear. In claims 2-14 it is unclear what further method steps the recited structure is supposed to imply. In claim 22 the "electrolytic media means" and RF electrode means" lack a positive recitation of function and to the extent that this claim is intended to encompass a device wherein the electrode contacts the skin, this claim is further indefinite. Claims 23 and 24 recite "The method of claim 22" while claim 22 is an apparatus claim. These claims will be treated as apparatus claims. In claims 25-31 it is unclear what further structure is to be claimed. In claim 33 "sensor means" lacks positive recitation of function. In claim 35 the "treating ..." step appears redundant in view of the "transferring ..." and "releasing ..." steps. In claim 36-52 it is unclear what further method step is claimed.

Claims 1-21 and 35-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 09/003,120. Although the conflicting claims are not identical, they are not patentably distinct from each other because It would have been obvious to use a skin smoothing method to treat wrinkles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 and 35-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 and 41-68 of copending Application No. 09/003,098. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use a skin tightening method to treat wrinkles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 and 35-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 and 56-89 of copending Application No. 09/003,180. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to the artisan of ordinary skill to use a method of treating elastosis to treat wrinkles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 and 35-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 55-65 of copending Application No. 08/942,274. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use a skin tightening method to treat wrinkles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 and 35-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31-54 of copending Application No. 08/990,494. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use a treatment method that tightens skin to treat wrinkles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 and 35-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-10, 12, 13 and 15-29

of copending Application No. 08/825,443. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use a skin smoothing method to treat wrinkles.

This is a provisional obvious-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 and 35-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 12-14, 16-20 and 55-61 of copending Application No. 08/583,815. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use a skin tightening method to treat wrinkles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 12-14, 21-29, 35-38 and 46-60 are of copending Application No. 08/827,237. Although the conflicting claims are not

identical, they are not patentably distinct from each other because it would have been obvious to use an ionic liquid as a coolant.

This provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28-40 of copending Application No. 09/003,098. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use an ionic fluid to cool the surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 35-55 of copending Application No. 07/003,180. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use an ionic fluid to cool the surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-54 of copending Application No. 08/942,274. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use an ionic fluid to cool the surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 22-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 08/990,494. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use an ionic fluid to cool the surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure of a means for detecting a wrinkle.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-21 and 35-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neefe in combination with Sand ('407). Neefe teaches a method as claimed except for cooling the surface. Sand ('407) teaches the desirability of providing surface cooling to control damage to the surface when treating underlying tissues. It would have been obvious to employ the energy types of Neefe in the method of Sand ('407), thus producing a method such as claimed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 22-34 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Eggers et al ('909).

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330

D. Shay:kst
January 6, 1999